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EXAMINER

SLAWSKI, BRIAN R

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/594,326	<b>Applicant(s)</b> DOWIDAT-ESKES ET AL.	
	<b>Examiner</b> BRIAN R. SLAWSKI	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16, 29 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 17-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>27 September 2006, 26 March 2008</u> .                        | 6) <input type="checkbox"/> Other: _____                          |

**PATTERNED LINOLEUM SHEETING**

***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-14 and 17-28, drawn to a method for producing a patterned linoleum sheeting, in the reply filed June 19, 2009, was received. Applicant argues that the special technical feature of the presently claimed invention is the method recited in claim 1, which is not taught by the prior art. This is not found convincing because, as defined by PCT Rules 13.1 and 13.2, a special technical feature is a feature shared by all of the claimed inventions and that distinguishes these inventions as claimed from the prior art. Claims 15, 29, and 30, drawn to "Patterned linoleum sheeting obtainable by a method as claimed in [Group I]," and claim 16, drawn to "Use of a patterned linoleum sheeting as claimed in Claim 15...", do not require the limitations of the method claimed in Group I because the same patterned linoleum sheeting could be made by alternate methods, e.g., by mixing the non-linoleum material directly into the linoleum precursor materials before rolling the latter out into a sheet. Hence the limitations of the method of Group I are not common to Groups II and III and thus cannot constitute a special technical feature. The examiner maintains that the only common technical feature of Groups I, II, and III is patterned linoleum sheeting having both linoleum and non-linoleum materials, a feature already well known in the art (see the Office Action issued on February 20, 2009). Hence, the requirement for restriction is still deemed proper under 37 CFR 1.499 and is

Art Unit: 1791

therefore made FINAL. Claims 15, 16, 29, and 30 are withdrawn from consideration as being drawn to a non-elected invention, the election having been made with traverse.

***Claim Rejections—35 USC §112***

2. Claims 2, 11, 25, and 27 are rejected under 35 U.S.C. 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.: Claim 2 recites, “...(a’) applying a non-linoleum material in the form of a solution, paste, suspension or dispersion to the scraped linoleum mixture...” (lines 3-4 of claim 2). However, no previous mention has been made in the claim of a scraped linoleum mixture, such that “the scraped linoleum mixture” here lacks antecedent basis. The examiner suggests that Applicant change “the scraped linoleum mixture” to “a scraped linoleum mixture” in this passage. Claim 11 recites, “...with the sections then being layered one above the other...” (line 8 of claim 11), where no antecedent basis for “the sections” has been provided in this claim. Claim 25 recites, “The method as claimed in Claim 2, wherein the flat layer is applied...” (line 1 of claim 25), where no antecedent basis for “the flat layer” has been provided in the base claim 2. Claim 27 recites, “The method as claimed in Claim 2, wherein the recesses in the green linoleum...” (lines 1-2 of claim 27), where no antecedent basis for “the recesses in the green linoleum” has been provided in the base claim 2.

Appropriate correction is required.

***Claim Rejections—35 USC §102***

Art Unit: 1791

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 5, 8, 17, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Markmann et al. (DE 199 15 868). (Citations to Markmann et al. refer to the corresponding US 7,297,366 which is the English language equivalent to Markmann DE '868).

Regarding claim 1, Markmann et al. teach a method for producing a patterned linoleum sheeting by rolling a green (i.e., unfinished) linoleum sheet B from a sheet rolling mill 1, dispersing a non-linoleum material (colored particles of a composition different from that of the rolled linoleum sheet) C onto the surface of the linoleum sheet B, cutting the resulting green linoleum into pieces about 2 m long, layering the cut green linoleum pieces with a sheet placer 6 to form a tiled stack of sheets E, and calendering the tiled stack of sheets in a sheet calender 7 to form patterned linoleum sheeting F (Fig. 1, 3, 4a; col. 2, L. 42-46, L. 50-57; col. 3, L. 3-9, L. 13-15, L. 28-30, L. 33-37, L. 50-55, L. 63-67; col. 4, L. 1-12, L. 45-50; col. 5, L. 34-57, L. 63-66; col. 6, L. 23-28).

Regarding claim 2, Markmann et al. teach a method for producing a patterned linoleum sheeting by forming the linoleum sheet B from a scraped (i.e., not yet calendered) linoleum mixture A, applying the non-linoleum material C in the form of a dispersion to the sheet B of scraped linoleum mixture, and calendering the scraped

Art Unit: 1791

linoleum mixture furnished with the non-linoleum material C in a mangle 5 to form a green (i.e., unfinished) linoleum sheeting (Fig. 1; col. 3, L. 3-4; col. 5, L. 34-47).

Regarding claim 3, Markmann et al. teach further processing the green linoleum by cutting it into pieces about 2 m long, layering the cut green linoleum pieces with a sheet placer 6 to form a tiled stack of sheets E, and calendering the tiled stack of sheets in a sheet calender 7 to form patterned linoleum sheeting F (col. 5, L. 47-57).

Regarding claims 5 and 17, Markmann et al. teach applying a non-linoleum material in the form of a pigment differing from that used to color the linoleum mixture (col. 3, L. 13-15).

Regarding claims 8 and 23, Markmann et al. teach applying the non-linoleum material as a flat layer either uniformly and continuously (i.e., across the green linoleum's entire width) or to only a portion of the green linoleum, e.g., in the form of geometric patterns (col. 3, L. 33-45).

### ***Claim Rejections—35 USC §103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 9 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markmann et al. as applied to claims 1-3, 5, 8, 17, and 23 above.

Regarding both of claims 9 and 25, Markmann et al. teach that the particles of the non-linoleum material particularly preferably have a diameter of 0.5 mm to 10 mm and can be applied as a flat layer embedded only in the topside of the green linoleum's top layer (col. 3, L. 20-25; col. 5, L. 24-25), so that it would have been obvious to one of ordinary skill in the art to apply the flat layer to the green linoleum in a thickness of 5  $\mu\text{m}$  to 1000  $\mu\text{m}$  (1 mm).

7. Claims 4, 10, 18, 24, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markmann et al. as applied to claims 1-3, 5, 8, 17, and 23 above, and further in view of Egleson (US 1,691,708).

Regarding claims 4 and 10, Markmann et al. do not specifically teach applying additional non-linoleum material to the green linoleum after calendering the scraped linoleum mixture A and pigmented non-linoleum material C through the mangle 5. However, Egleson teaches a method of providing additional decoration to a linoleum sheet 1 already having a desired color pattern formed therein, by embossing a pattern 4 of light-reflecting V-shaped grooves 5 in the surface of the linoleum sheet, e.g., with an embossing roll, then filling the grooves with a transparent non-linoleum coating 10. Egleson teaches that the resulting pattern of light-reflecting surfaces recessed beneath the transparent coating produces a striking and attractive contrast with the smooth portions of the linoleum (Fig. 1-3; p. 1, L. 6-23, L. 33-39, L. 49-67, L. 84-97; p. 2, L. 4-22, L. 49-59), so that it would have been obvious to one of ordinary skill in the art to apply Egleson's embossed predetermined recesses and non-linoleum coating therein

Art Unit: 1791

onto the green linoleum of Markmann et al. after its calendering through the mangle 5, in order to provide the green linoleum with a more attractive surface.

With particular regard to claim 10, Egleson depicts grooves 5 formed in the linoleum sheet 1 to a depth of about 35-40% of the linoleum sheet's thickness (Fig. 2, 3), so that it would have been obvious to one of ordinary skill in the art to apply such grooves onto the linoleum sheet of Markmann et al. to have a depth from 5% to 60% of the linoleum sheet's thickness.

Regarding claim 18, Markmann et al. teach applying a non-linoleum material in the form of a pigment differing from that used to color the linoleum mixture (col. 3, L. 13-15).

Regarding claim 24, Markmann et al. teach applying the pigmented non-linoleum material as a flat layer either uniformly and continuously (i.e., across the green linoleum's entire width) or to only a portion of the green linoleum, e.g., in the form of geometric patterns (col. 3, L. 33-45). Further, as explained with respect to claim 4 above, it would have been obvious to one of ordinary skill in the art to apply Egleson's predetermined grooves 5, which may extend the entire width or only a portion of the width of the linoleum sheet (Fig. 1), and groove-filling transparent non-linoleum coating 10 onto the linoleum of Markmann et al. in order to provide a more attractive appearance thereto.

Regarding claim 26, Markmann et al. teach that the particles of the non-linoleum material C particularly preferably have a diameter of 0.5 mm to 10 mm and can be applied as a flat layer embedded only in the topside of the green linoleum's top layer



Art Unit: 1791

(col. 3, L. 20-25; col. 5, L. 24-25), so that it would have been obvious to one of ordinary skill in the art to apply the flat layer to the green linoleum in a thickness of 5  $\mu\text{m}$  to 1000  $\mu\text{m}$  (1 mm).

Regarding claim 28, it would have been obvious to the skilled artisan to form grooves in the linoleum sheet of Markmann et al. with a depth from 5% to 60% of the linoleum sheet's thickness, because Egleson teaches such grooves extending about 35-40% into the linoleum sheet's thickness, as explained with respect to claim 10 above.

8. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Markmann et al. as applied to claims 1-3, 5, 8, 17, and 23 above, and further in view of Egleson.

As discussed in paragraph 9 above, while Markmann et al. do not disclose forming recesses in the green linoleum, Egleson teaches providing additional decoration to a colored patterned linoleum sheet by embossing a pattern of light-reflecting grooves therein, to a depth of about 35-40% of the linoleum sheet's thickness, and filling these with a transparent non-linoleum coating, so that it would have been obvious to one of ordinary skill in the art to apply such non-linoleum-filled grooves onto the linoleum sheet of Markmann et al. to a depth from 5% to 60% of the sheet's thickness.

9. Claims 6, 7, 19, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markmann et al. as applied to claims 1-3, 5, 8, 17, and 23 above, and further in view of Humphreys et al. (US 1,873,587).

Art Unit: 1791

Regarding all of claims 6, 7, 19, and 21, Markmann et al. do not specifically teach using a metal powder or effect pigment as the non-linoleum material C used to decorate the linoleum sheet B. However, Humphreys et al. also teach a method of decorating a linoleum sheet 6 by dispersing and embedding a non-linoleum material 7 onto the surface or into the depth thereof. Humphreys et al. teach that lustrous materials are preferred, such as aluminum powder for providing the linoleum with a metallic sheen, or an effect pigment based on mica for providing the linoleum with an appearance resembling natural stone (Fig. 1, 2; p. 1, L. 1-15, L. 23-68, L. 74-77), so that it would have been obvious to one of ordinary skill in the art to substitute these materials for the non-linoleum material of Markmann et al. in order to provide the alternative visual effects taught by Humphreys et al.

10. Claims 20 and 22 are rejected under Markmann et al. and Egleson as applied to claims 4, 10, 18, 24, 26, and 28 above, and further in view of Humphreys et al., for the same reasons cited in paragraph 11 above; Applicant is referred to the same for a complete discussion of these rejections.

11. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markmann et al. in view of Stroppiana (US 5,217,554).

Regarding claim 11, Markmann et al. teach a method for producing a patterned (marbled or speckled) linoleum sheeting by producing a single-color or multicolor green (i.e., unfinished) linoleum sheet B from a sheet rolling mill 1, coating the green linoleum

Art Unit: 1791

B with a non-linoleum material in the form of colored particles C, calendering the coated green linoleum in a mangle 5 to form a marbled or speckled surface thereon, cutting the resulting green linoleum into pieces about 2 m long, layering the cut green linoleum pieces with a sheet placer 6 to form a tiled stack of sheets E, and calendering the tiled stack of sheets in a sheet calender 7 to form patterned linoleum sheeting F, which is further processed by connecting to a conventional substrate fabric G to form a final linoleum sheeting (Fig. 1, 3, 4a; col. 1, L. 18-40; col. 2, L. 58-62; col. 3, L. 3-9, L. 13-15, L. 28-30; col. 4, L. 45-52, L. 57-60; col. 5, L. 34-57). Markmann et al. do not specifically teach processing the coated green linoleum to form granules or chips immediately after calendering through the mangle 5 or after cutting, layering, and calendering through sheet calender 7. However, Markmann et al. teach that in similar processes for making speckled linoleum sheets from mixed multicolored materials, the patterning tends to elongate undesirably upon calendering, and note that, while their process unexpectedly reduces this effect, some orientation of the speckles by calendering may occur in their finished linoleum sheet (col. 2, L. 35-41; col. 4, L. 26-33).

Stroppiana also addresses the problem of orientation of marbled or speckled patterns in linoleum upon calendering, by scraping the surface of such a calendered linoleum A to form granules or chips 6, which are then allowed to fall back onto the scraped linoleum sheet downstream and be recompressed thereunto by rollers 7, producing a linoleum sheet with uniform non-oriented speckles (Abstract; Fig. 1, 4, 5; col. 1, L. 7-18, L. 21-29; col. 2, L. 35-50, L. 56-63; col. 3, L. 21-34, L. 39-48).

Stroppiana further notes that, alternatively, the chips may be deposited on a different

Art Unit: 1791

substrate or compressed directly to form a new linoleum cover sheet without the use of a substrate (col. 3, L. 67-68; col. 4, L. 1-9). Thus it would have been obvious to one of ordinary skill in the art to apply Stroppiana's post-calendering treatment to form chips from the coated and calendered linoleum of Markmann et al., and then to compress the chips into a linoleum sheet, in order to ensure that the linoleum's pattern is not distorted after calendering.

Regarding claim 12, Markmann et al. teach applying a non-linoleum material in the form of a pigment differing from that used to color the linoleum mixture (col. 3, L. 13-15).

12. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markmann et al. in view of Stroppiana as applied to claims 11 and 12 above, and further in view of Humphreys et al., for the same reasons cited in paragraph 11 above; Applicant is referred to the same for a complete discussion of these rejections.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN R. SLAWSKI whose telephone number is (571)270-3855. The examiner can normally be reached on Monday to Thursday, 7:30 a.m. to 5:00 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino, can be reached on (571) 272-1226. The fax phone

Art Unit: 1791

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Brian R. Slawski/  
Examiner, Art Unit 1791

/Jeff Aftergut/  
Primary Examiner, Art Unit 1791

B.R.S.